

REMARKS

Claims 1 – 42 remain in the application and stand finally rejected. Although this Response is being timely filed, the Commissioner is hereby authorized to charge any additional fees that may be required for this paper or credit any overpayment to Deposit Account No. 50-3818.

The MPEP provides in pertinent part “the examiner should always look for enabled, allowable subject matter and communicate to applicant what that subject matter is at the earliest point possible in the prosecution of the application.” MPEP 2164.04 (emphasis original).

Claims 1, 2, 5, 7 – 10, 12 – 19, 21, 22, 25, 27 – 30, and 32 – 39 are finally rejected under 35 U.S.C. §102(e) or 103(a) over published U.S. Patent application No. 2002/0129057 to Spielberg. Claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40 are finally rejected under 35 U.S.C. §103(a) over Spielberg in combination with published European Patent Application No. EP-0-865-189-A2 to Pizano et al. Claims 41 and 42 are finally rejected under 35 U.S.C. §103(a) over Spielberg in combination with U.S. Patent No. 5,754,844 to Fuller et al. The final rejection is respectfully traversed.

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

MPEP §2131.

In responding to the applicant's remarks in the previous amendment, the final office action (Final) characterizes that response as: "Applicant argues that the claimed invention *inserts*

an annotation into an original message, whereas **SPIELBERG** creates an annotation and later inserts said file into original document.” Page 2, #2 (italics and emphasis original, underscore added). Disagreeing with this assertion, the Final maintains the rejection. However, this is not what the applicant has argued.

Speilberg specifically teaches that “there are **four** basic files associated with the annotation of a document as shown in FIG. 12. These files comprise the original document 1200 (i.e., the document to be annotated). The Annotations Names File 1202, the Annotations Index File 1204, and the Annotations File 1206.” Paragraph 0095. Furthermore, “Document File 1200 comprises the document to be annotated and is **not typically modified during annotation.**” Paragraph 0096 (emphasis added). “Once the comments are stored in the file structure they may be reconstructed upon request by a user. A user may, for example, provide the annotated document to a secretary or some other person in order to finalize the document. In other instances the document is stored for later processing by another person.” Paragraph 0103. There is nothing here or anywhere else in Spielberg, as far as the applicant can tell, about inserting the annotations into the document to produce an annotated document. Quite the opposite in fact.

By contrast, as previously noted, claim 1 recites a “method for **inserting** a caller’s speech annotations **into** an original message,” at line 1 (emphasis added). *See also*, claim 21, line 1. So the claims recite, not just providing annotations, but *inserting* those annotations *into* the original message. This is done by “annotating [a] speech message with at least one speech annotation; and **inserting** [that] speech annotation **into** said original message.” Claim 1 lines 4 – 5 (emphasis added). *See also*, claim 21, lines 4 – 5.

Be that as it may, the Final turns to the present application to find the description of how each annotation may be added, referring to page 5, lines 27 – 32, to assert that “it would seem from the applicants’ own disclosure that a sound file of an annotation is created, stored and then later re-aligned with the original message.” Final, page 3, #2. Applicant does not necessarily concede that the claims are or, are not, restricted as to when the annotations are inserted into a file being annotated. Regardless of when the annotations are inserted, whether as each

annotations is completed or, after all annotations are completed, that is not what Spielberg teaches.

Instead, Spielberg teaches generating additional annotation files for the original document, which is maintained separate and pristine; and so, Spielberg fails to teach a “method for **inserting** a caller’s speech annotations **into** an original message,” by “**inserting** said speech annotation **into** said original message.” *Supra*. Therefore, Spielberg fails to teach the present invention as recited in claims 1 and 21.

Moreover, dependent claims include all of the differences with the references, as the claims from which they depend. MPEP §2143.03 (“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).”). Therefore, Spielberg fails to teach the present invention as recited by claims 2, 5, 7 – 10, 12 – 19, 22, 25, 27 – 30, and 32 – 39, which depend from claims 1 and 21. Reconsideration and withdrawal of the final rejection of claims 1, 2, 5, 7 – 10, 12 – 19, 21, 22, 25, 27 – 30, and 32 – 39 under 35 U.S.C. §§102(e) and 103(a) is respectfully requested.

Furthermore, because Spielberg teaches augmenting the original file with associated separate annotation files (*supra*), and specifically teaches forwarding all of those separate files for annotation (*supra*) by others or even, just for reviewing others’ annotations; “forwarding said annotated message [singular] to another user,” as recited by claims 20 and 40, is neither taught nor suggested by Spielberg, Pizano et al. or any other reference of record.

Nor does either of Pizano et al. (cited to teach an original message containing an attachment) or Fuller et al. (cited to teach querying whether to overwrite or save as new) teach or suggest what is missing from Spielberg. Therefore, the combination of Pizano et al. with Spielberg fails to result in the present invention as recited in claims 1 and 21, from which claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40 – 42 depend. Therefore, the combination of Pizano et al. with Spielberg does not make obvious the present invention as recited in claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40 – 42. Reconsideration and withdrawal of the final rejection of claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40 – 42 under 35 U.S.C. §103(a) is respectfully requested.

The applicant thanks the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance for the reasons set forth above, the applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1 – 42 under 35 U.S.C. §§102(b) and 103(a) and allow the application to issue.

As the Applicant has previously noted that MPEP §706 “Rejection of Claims,” subsection III, “PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED” provides in pertinent part that

If **the examiner** is satisfied after the search has been completed that patentable subject matter has been **disclosed** and the record indicates that the applicant intends to claim such subject matter, he or she **may note** in the Office action that **certain aspects or features** of the patentable invention have not been claimed and that if properly claimed such claims **may be given favorable consideration**.

(emphasis added). The applicant believes that the written description of the present application is quite different than, and not suggested by, any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Respectfully submitted,

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